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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/706,878 | 11/12/2003 | Andreas Leukert-Knapp | 13906-115US2 / 2001P00007 | 6758 |
| 32864 | 7590 | 03/13/2007 | EXAMINER | |
| FISH & RICHARDSON, P.C. PO BOX 1022 MINNEAPOLIS, MN 55440-1022 | | | TRAN, PHILIP B | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2155 | |

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS | 03/13/2007 | PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/706,878

Applicant(s)

LEUKERT-KNAPP ET AL.

Examiner

Philip B. Tran

Art Unit

2155

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 April 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 20-43 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 20-43 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date <u>11/12/03 & 4/9/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Double Patenting

1. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

2. Claims 20-43 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 20-43 of copending Application No. 10/469,336. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 32-43 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 32 is not limited to tangible embodiments. The claim recited "A computer readable medium or propagated signal ... configured to" is nonstatutory. Since in view of Applicant's disclosure at page 4 lines 1-14, the computer readable medium also includes " (a) magnetic media, like a hard disk, a floppy disk, or other magnetic disk, a tape, a cassette tape; (b) optical media, like optical disk (CD-ROM, digital versatile disk - DVD); (c) semiconductor media, like DRAM, SRAM, EPROM, EEPROM, memory stick, or by any other media, like **paper**". In addition, the claim recited "**propagated signal**". As such, a propagated signal or a media like a paper does not fall within the statutory category of a machine, or a process, or a manufacture. Thus, the claim is not limited to statutory subject matter and is therefore nonstatutory.

Claims 33-43 are not limited to statutory subject matter as discussed above (under the same rationale) and are therefore also nonstatutory.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 20-26, 28-38 and 40-42 are rejected under 35 U.S.C. 102(e) as being anticipated by Faour et al (Hereafter, Faour), U.S. Pat. No. 6,857,017.

Regarding claim 20, Faour teaches a method for issuing notification messages to users of a computer network [see Abstract], the method comprising:

creating a distribution list of a first group of users from a role-to-user assignment and from an application-to-role assignment, wherein each user in the first group has access to information in a business application used in the application-to-role assignment (= list of users with role-to-user assignment associated with having event messages corresponding to elements (applications) such as business objects and batch jobs wherein each user in the list has access to information based on the user's role) [see Abstract and Figs. 1-2 & 6-7 and Col. 5, Line 63 to Col. 6, Line 20 and Col. 7, Line 35 to Col: 8, Line 8]; and

issuing a first notification message to a communication device corresponding to each user in the first group when a current value of a predetermined variable in the business application is in a predetermined relation to a reference value (= a user may have certain notifications (alerts) sent to their desktops by registering for selected events and groups of events) [see Abstract and Figs. 1 & 6 and Col. 6, Line 21 to Col. 7, Line 28].

Regarding claim 21, Faour further teaches the method of claim 20, further comprising issuing a further notification message to a communication device corresponding to a further user outside the first group of users in the event that during a

predetermined time period no user from the first group has confirmed reception of the first notification message [see Col. 5, Lines 23-58 and Col. 7, Lines 15-20].

Regarding claim 22, Faour further teaches the method of claim 21, wherein reception of the first notification message is confirmed when one or more users from the first group returns a receipt message (= acknowledgment by a user) [see Col. 6, Lines 53-56].

Regarding claim 23, Faour further teaches the method of claim 22, further comprising assigning a unique identification number to the first notification message such that the communication device returns the identification number as part of the receipt message [see Col. 4, Line 59 to Col. 5, Line 7].

Regarding claim 24, Faour further teaches the method of claim 21, wherein the further notification message has a description portion to indicate being the further notification [see Col. 4, Lines 19-27 and Col. 5, Lines 23-58 and Col. 7, Lines 15-20].

Regarding claim 25, Faour further teaches the method of claim 21, wherein the further user has a supervisory relationship with the first group of users (= event handler or alert manager) [see Col. 3, Lines 25-52 and Col. 5, Lines 23-58].

Regarding claim 26, Faour further teaches the method of claim 20, wherein the first notification message is issued to the communication device such that the communication device visually presents the first notification message [see Abstract and Col. 1, Line 65 to col. 2, Line 7].

Regarding claim 28, Faour further teaches the method of claim 26, wherein the communication device visually presents the first notification message as a hyperlink to a full version of the first notification message (= dashboard window includes a hyperlink) [see Col. 6, Line 41 to Col. 7, Line 6].

Regarding claim 29, Faour further teaches the method of claim 20, wherein the distribution list is created after detecting that the current value of predetermined variable in the business application is in the predetermined relation to a reference value [see Abstract and Figs. 1-2 & 6-7 and Col. 5, Line 63 to to Col. 7, Line 28 and Col. 7, Line 35 to Col. 8, Line 8]

Regarding claim 30, Faour further teaches the method of claim 20, wherein the application-to-role assignment includes an alert-type-to-role assignment [see Figs. 6-7 and Col. 5, Line 63 to Col. 7, Line 14].

Claims 32-38 and 40-42 are rejected under the same rationale set forth above to claims 20-26 and 28-30, respectively.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

8. Claims 27 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Faour et al (Hereafter, Faour), U.S. Pat. No. 6,857,017 in view of Zothner, U.S. Pat. No. 6,751,657.

Regarding claim 27, Faour does not explicitly teach wherein the communication device is a personal computer with electronic mail. However, Zothner, in the same field of notifications based on user role endeavor, discloses a communication device (computers) involves with receiving notifications such as e-mail [see Zothner, Col. 2,

Lines 15-25 and Col. 22, Lines 25-65]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Zothner into the teaching of Faour in order to efficiently facilitate notifications between devices by reducing the time for communication.

Claim 39 is rejected under the same rationale set forth above to claim 27.

Regarding claim 31, Faour does not explicitly teach receiving subscription requests to selectively add or remove individual users to or from the distribution list. However, Zothner, in the same field of notifications based on user role endeavor, discloses selectively add or remove individual users (customers) from the subscription list [see Zothner, Col. 4, Line 62 to Col. 5, Line 12 and Col. 22, Line 25 to Col. 23, Line 12]. It would have been obvious to one of ordinary skill in the art at the time of the invention was made to incorporate the teaching of Zothner into the teaching of Faour in order to efficiently facilitate notifications between devices by updating the information regarding availability and reliability of network elements.

Claim 43 is rejected under the same rationale set forth above to claim 31.

Other References Cited

9. The following references cited by the examiner but not relied upon are considered pertinent to applicant's disclosure.

A) Snavelly et al, U.S. Pat. No. 6,772,167.

B) Leymann et al, U.S. Pat. No. 6,725,445.

C) Zhuk, U.S. Pat. No. 7,032,006.

D) Gullotta et al, U.S. Pat. No. 6,985,955.

E) Win et al, U.S. Pat. No. 6,161,139.

F) Kahn, U.S. Pat. No. 7,185,192.

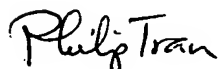
G) Barkley et al, U.S. Pat. No. 6,202,066.

H) Cheng, U.S. Pat. No. 6,067,548.

10. A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS ACTION IS SET TO EXPIRE THREE MONTHS FROM THE MAILING DATE OF THIS COMMUNICATION. FAILURE TO RESPOND WITHIN THE PERIOD FOR RESPONSE WILL CAUSE THE APPLICATION TO BECOME ABANDONED (35 U.S.C. § 133). EXTENSIONS OF TIME MAY BE OBTAINED UNDER THE PROVISIONS OF 37 CAR 1.136(A).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip Tran whose telephone number is (571) 272-3991. The Group fax phone number is (571) 273-8300. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Saleh Najjar, can be reached on (571) 272-4006.

12. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Philip B. Tran
Primary Examiner
Art Unit 2155
March 03, 2007